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| 40987  | 7590        | 08/20/2007           | EXAMINER             |                  |
| AKERMAN SENTERFITT<br>P. O. BOX 3188<br>WEST PALM BEACH, FL 33402-3188 |             |                      | LERNER, MARTIN       |                  |
|  |             | ART UNIT             | PAPER NUMBER         |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/626,050             | DAVIS ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Martin Lerner          | 2626                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS,  
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 July 2007.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 to 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 to 19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 to 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 8, and 18 set forth amended claim language directed to "a conventional teleconferencing system", which involves new matter. Applicants' originally-filed Specification does not disclose a conventional teleconferencing system. The Specification, ¶[0014] - ¶[0015], discloses a conventional phone, but the teleconferencing system is not stated to be conventional. Indeed, the teleconferencing system disclosed is not completely conventional because it enables an instant messaging conference.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 to 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 8, and 18 set forth amended claim language directed to "a conventional teleconferencing system", which is indefinite. One having ordinary skill in the art would not understand the scope of what is encompassed by a conventional teleconferencing system. Applicants' Specification does not define what is intended by "a conventional teleconferencing system", nor provide any instances of it. It would not be clear that a conventional teleconferencing system would exclude a video conferencing capability.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 to 19 are rejected under 35 U.S.C. 102(e) as being anticipated by *Moore et al. ('041)*.

Regarding independent claims 1 and 18, *Moore et al. ('041)* discloses a method and machine readable program code for responding to messages, comprising:

“receiving a speech input from a telephone through a conventional teleconferencing system” – speech information from a user using a telephone 62 is carried through PSTN 60 and arrives as a conventional telephone signal at VoIP gateway 54 (Page 10: ¶[0105]: Figure 1); intelligent chat gateway 52 manages messaging communications among a plurality of parties (Page 2: ¶[0030], Page 8: ¶[0096]); thus, managing communication among a plurality of parties is equivalent to “a conventional teleconferencing system”; moreover, service provider system 30 may include, without limitation, conference call establishment (Page 7: ¶[0087]); a capability to include conference call establishment is equivalent to “a conventional teleconferencing system”;

“transcribing the speech into a first text message” – the packetized data stream is directed to speech-to-text module 74 to convert the received speech signals into a textual representation (Page 10: ¶[0105]: Figure 1);

“transmitting the first text message to a plurality of devices coupled to an instant messaging network belonging to the instant messaging based conference” – the textual information may then be sent to a text chat interface of chat client 14, perhaps in the form of a typical chat message, via network 20 and perhaps involving IM service 22; an optional instant messaging sender 79a is depicted along connection 76 representing

adaptation of the speech-to-text module 74 to carry on instant communications with chat client 14 (Page 10: ¶[0105]: Figure 1); a chat client 14 supports communications with one or more principals, and instant messaging through which text messages can be exchanged in real time with one or more other parties (“to a plurality of devices coupled to an instant messaging network belonging to the instant messaging based conference”) (Page 6: ¶[0075], Page 7: ¶[0082]);

“receiving a second text message from any one among the plurality of devices on the instant messaging based conference” – intelligent media translator (IMT) 70 may comprise a port for receiving textual information from a messaging client (Page 10: ¶[0104]: Figure 1); chat client 14 may be implemented by or based upon well known instant messaging (Page 6, ¶[0075]: Figure 1);

“converting the second text message to a speech output” – intelligent media translator 70 comprises a text-to-speech conversion process for converting the received textual information into corresponding speech signals via a text-to-speech module 72 (Page 10: ¶[0103] - ¶[0104]: Figure 1);

“transmitting the speech output to the telephone via the conventional teleconferencing system” – speech signals are sent through a communications medium, such as a telephone connection or RTP session, to a chat client 14 or telephone 62 (Page 10: ¶[0103] - ¶[0104]: Figure 1).

Regarding independent claim 8, *Moore et al. ('041)* discloses a messaging response system, comprising:

“an input port for receiving a calling party’s speech input via a conventional teleconferencing system” – intelligent media translator (IMT) 70 may comprise a port for receiving speech signals from a chat client 14 or from telephones 62 (Page 10: ¶[0104] - ¶[0105]; Figure 1); intelligent chat gateway 52 manages messaging communications among a plurality of parties (Page 2: ¶[0030], Page 8: ¶[0096]); thus, managing communication among a plurality of parties is equivalent to “a conventional teleconferencing system; moreover, service provider system 30 may include, without limitation, conference call establishment (Page 7: ¶[0087]); a capability to include conference call establishment is equivalent to “a conventional teleconferencing system”;

“a speech-to-text converter for converting the calling party’s speech input to a text message for transmission to an instant messaging system” – speech-to-text module 74 converts between speech signals received from telephones such as telephone 62 and text chat employed by chat client 14 (Page 10: ¶[0104]; Figure 1); chat client 14 may be implemented by or based upon well known instant messaging (Page 6, ¶[0075]; Figure 1);

“a text-to-speech converter for converting text messages received form the instant messaging system to a speech output for transmission to the conventional teleconferencing system” – text-to-speech module 72 converts between text chat employed by chat client 14 by speech synthesis to provide speech signals for telephones such as telephone 62 (Page 10: ¶[0104]; Figure 1).

Regarding claims 2, 13, and 17, *Moore et al. ('041)* discloses a profile is maintained for a given user ("a user profile") as a preference as to how synthesized speech presented to him is rendered ("voice signature"); aspects of speech rendering include whether a male or female voice is preferred, approximate speaker age, vocal characteristics, inflection, and local dialect; in some implementations, a party may elect to use a speech persona that is whimsical or that emulates the characteristics of a popular recognizable personality ("at least one of . . . customized speech output . . . as defined by the user").

Regarding claims 3, 7, and 12, *Moore et al. ('041)* discloses text is converted to speech by text-to-speech module 72 employing speech synthesis technology. (Page 10: ¶[0103]: Figure 1)

Regarding claims 4, 5, 11, and 19, *Moore et al. ('041)* discloses that in the course of converting speech and other audible signals into corresponding symbols or text, IMT 70 may also perform translation among different spoken and written languages, for example, converting English text to Spanish speech and vice-versa. (Page 11: ¶[0112])

Regarding claim 6, *Moore et al. ('041)* discloses that, after the packetized data stream is converted into a textual representation by speech-to-text module 74, the textual information is then sent via network 20 ("transmitting a text stream"). (Page 10: ¶[0105]: Figure 1)

Regarding claim 9, *Moore et al. ('041)* discloses gateway system 50 coupled to network 20 or provider system 30 supports the completion of calls between data processing system 12 and stations (i.e. telephone 62) within wireless or wired telephony

networks, such as Public Switched Telephonic Network (PSTN) 60; intelligent chat gateway 52 manages messaging communications among a plurality of parties (Page 2: ¶[0030], Page 8: ¶[0096]); moreover, service provider system 30 may include, without limitation, conference call establishment (Page 7: ¶[0087]); a capability to include conference call establishment is equivalent to “a conventional teleconferencing system”.

Regarding claim 10, *Moore et al. ('041)* discloses that a data processing system 12 may comprise a laptop or handheld computer system, a personal digital assistant (PDA), or a mobile telephone to execute chat client 14 as an application, and to provide chat-based services. (Page 6: ¶[0074]: Figure 1)

Regarding claim 14, *Moore et al. ('041)* discloses that chat client 14 may present a user interface that is within a display device of data processing system 12; chat client 14 has an instant messaging window through which text messages are presented, as well as images and video. (Page 7 ¶[0079]: Figure 2, Page 7: ¶[0082]: Figure 1)

Regarding claim 15, *Moore et al. ('041)* discloses that text messages are exchanged in real time. (Page 7: ¶[0082]: Figure 1)

Regarding claim 16, *Moore et al. ('041)* discloses instant communications by establishing sessions through a network by a TCP/IP connection (Page 5: ¶[0061] - ¶[0062]); a TCP/IP connection involves “data transmission protocols” for communications over the Internet.

***Response to Arguments***

7. Applicants' arguments filed 20 July 2007 have been fully considered but they are not persuasive.

Applicants' argument is that independent claims 1, 8, and 18, as amended, are allowable because *Moore et al.* ('041) fails to disclose a conventional teleconferencing system. Applicants say that *Moore et al.* ('041) discloses a telephone that is either an IP telephone 92 or a conventional telephone 62 connected through a VoIP gateway 54, but conventional teleconferencing system is not provided. Applicants maintains that *Moore et al.* ('041) discloses video conference establishing, which the rejection states is equivalent to "a teleconferencing system", but argues that video conferences are not traditionally offered by telephony service providers, and thus, the intelligent chat gateway 52 is not equivalent to a conventional teleconferencing system.

Fundamentally, Applicants note, *Moore et al.* ('041) provides no teaching to enable conventional phone users to participate in an instant messaging based conference. Applicants' arguments are traversed.

Firstly, Applicants' amendments to independent claims 1, 8, and 18, now requiring that speech is input and transmitted through "a conventional teleconferencing system", raise new issues under 35 U.S.C. §112, 1<sup>st</sup> and 2<sup>nd</sup> ¶'s, necessitated by amendment.

The term "a conventional teleconferencing system" raises issues of new matter under 35 U.S.C. §112, 1<sup>st</sup> ¶, because Applicants' Specification as originally filed does not expressly disclose that the teleconferencing system is conventional, nor does it

imply any instances of what constitutes a conventional teleconferencing system.

Indeed, one skilled in the art would not necessarily find that Applicants' teleconferencing system is entirely conventional insofar as it enables an instant messaging based conference rather than a voice conference among the parties.

Moreover, the term "a conventional teleconferencing system" raises issues of indefiniteness under 35 U.S.C. §112, 2<sup>nd</sup> ¶, because one skilled in the art would not know what is encompassed by the term, nor would the scope of the term be clear. Does a conventional teleconferencing system require teleconferencing only between two landline telephones or could it involve a teleconference among cellular telephones? Could an IP network be an element of a conventional teleconferencing system, or does a conventional teleconferencing system require that all the elements connected to the network be conventional? Does a conventional teleconferencing system exclude a video teleconference capability? From what point in time is the conventionality of the teleconferencing system to be measured? Fundamentally, Applicants are amending their claimed method, system, and computer program in an attempt to exclude a video conferencing capability disclosed by *Moore et al. ('041)*, implying that a video conferencing capability is not a part of a conventional teleconferencing system.

However, it is not clear that one skilled in the art would necessarily exclude a video conference capability from a conventional teleconferencing system, nor find that Applicants' instant messaging based conference involves a conventional teleconferencing system. Applicants' Specification does not provide any express or

implied definition of what is intended by the term "a conventional teleconferencing system", so that the scope of what is encompassed by the term is indefinite.

Secondly, it is maintained that "a conventional teleconferencing system" is disclosed by *Moore et al. ('041)*. Applicants' position appears to be predicated upon the notion that *Moore et al. ('041)* does not disclose a conventional teleconferencing system because a video conference is not a conventional aspect of a teleconference. However, *Moore et al. ('041)* only discloses a video conference as one of a plurality of non-limiting optional services. (Pages 7 to 8: ¶[0087]) Furthermore, it is contended that *Moore et al. ('041)* discloses an intelligent chat gateway 52 manages messaging communications among a plurality of parties (Page 2: ¶[0030], Page 8: ¶[0096]). Generally, one skilled in the art would recognize that managing communication among a plurality of parties is equivalent to "a conventional teleconferencing system". Finally, *Moore et al. ('041)*, at Page 7, ¶[0087], expressly states: "service provider system 30 may include, without limitation, . . . , conference call establishment, . . ." Thus, conference call establishment disclosed by *Moore et al. ('041)* does not require that the service include a video conference capability, and meets the limitation of "a conventional teleconferencing system."

Therefore, the rejections of claims 1 to 19 under 35 U.S.C. §112, 1<sup>st</sup> ¶, as failing to comply with the written description requirement, of claims 1 to 19 under 35 U.S.C. §112, 2<sup>nd</sup> ¶, as being indefinite, and of claims 1 to 19 under 35 U.S.C. §102(e) as being anticipated by *Moore et al. ('041)*, are proper.

***Conclusion***

8. Applicants' amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (571) 272-7608. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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8/14/07

  
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